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23 JUL 2007

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In re Application of
HOFMANN, Albrecht et al.
Application No.: 10/511,285
PCT No.: PCT/DE03/01079
Int. Filing Date: 02 April 2003
Priority Date: 18 May 2002
Attorney's Docket No.: 2998
For: System With A Tool-Holding Fixture

DECISION
ON RENEWED PETITIONS
UNDER 37 CFR 1.137(b)
AND 1.47(a)

This decision is issued in response to applicants' "Renewed Petition Under 37 CFR 1.137(b) and 1.47(a)" filed on 26 March 2007. No petition fee is required.

BACKGROUND

On 02 April 2003, applicant filed international application PCT/DE03/01079, claiming an earliest priority date of 18 May 2002. The thirty-month period for paying the basic national fee in the United States expired at midnight on 18 November 2004.

On 14 October 2004, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied, *inter alia*, by the requisite basic national fee and a declaration executed by three of the four inventors. The declaration included an unsigned signature block for the remaining inventor Markus Heckmann, with a handwritten statement that the inventor "Died 2004/06/12."

On 23 November 2005, the Office mailed "Communication regarding Submission Under 37 CFR 1.42," finding that the declaration, filed on 14 October 2004, to be defective because it was not executed on behalf of the deceased inventor by his heirs or by his legal representative in accordance with 37 CFR 1.42. The Communication provided applicants two months to respond with the possibility of purchasing extensions of time according to 37 CFR 1.136(a).

On 24 June 2006, the instant application became abandoned due to applicants' failure to file a timely response to the Communication mailed 23 November 2005.

On 17 January 2007, applicants filed a "Petition To Revive" the instant application (treated as a petition under 37 CFR 1.137(b)). The petition included a revised declaration submitted on behalf of deceased inventor Markus Heckmann (treated as a submission under 37 CFR 1.42) and an assertion that the legal representative of the deceased inventor, Kerstin Heckmann, has refused to execute the declaration (treated as a petition under 37 CFR 1.47(a)).

On 09 February 2007, the Office mailed a Decision dismissing applicants' petition for revival for failure to satisfy all the requirements of a grantable petition. Specifically, applicants had not provided the "required reply," that is, a declaration acceptable under 37 CFR 1.42 and 1.497, or a grantable petition under 37 CFR 1.47(a) for acceptance of a declaration without the signature of the legal representative.

On 20 February 2007, applicants filed a renewed petition for revival of the instant application. The petition included copies of two letters mailed to the last known address of the legal representative, dated June 8, 2005 and respectively, September 20, 2005.

On 15 March 2007, the Office mailed a Decision dismissing applicants' petition for revival for failure to satisfy all the requirements of a grantable petition. Specifically, applicants had not provided the "required reply," that is, evidence that the legal representative had been presented with a complete copy of the application and that the copy was received. Further, the decision noted that although applicants refer to a written statement of refusal by the legal representative, applicants have not provided a copy of such statement.

On 26 March 2007, applicants filed the instant renewed petition for revival of the instant application. The petition included a copy of a letter from the legal representative of the deceased inventor, dated 19 September 2005, as evidence of refusal to execute the declaration in the instant application. Also included was a copy of a letter mailed to the legal representative, dated 17 October 2005, including a copy of the application in both the German and the English languages and, a copy of a Federal Express acknowledgment receipt purportedly showing delivery of the letter at the last known address of the legal representative.

DISCUSSION

I. Renewed Petition Under 37 CFR 1.47(a)

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(g), (2) a statement of the last known address of the missing inventor, (3) an oath or declaration by each applicant on his or her own behalf and on behalf of the non-signing joint inventor and, (4) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort.

As to items (1) and (2), applicants have submitted the correct petition fee of \$200.00 under 37 CFR 1.17(g) and a statement of the last known address of the legal representative of the deceased inventor.

With regard to item (3), applicants have filed a declaration executed by the other cooperating inventors and containing an unsigned signature block for the deceased inventor and set forth the legal representative's name, address and citizenship.

With regard to item (4), the petition states that Kerstin Heckmann refuses to sign the application papers. The petition adequately demonstrates that a bona fide attempt was made to present a copy of the application papers to Heckmann for signature (see letter dated 17 October 2005). However, the petition fails to sufficiently illustrate that Heckmann refuses to sign. The letter from Heckman dated 19 September 2005 merely states that she has disclaimed any rights to the invention, not that she refuses to sign the application papers. Lack of financial interest in a patent application does not relieve the inventor or his legal representative of the duty to sign. It is noted that if petitioner can establish that the letter to Heckman dated 17 October 2005 was either personally received by Ms. Heckman or that she resided at the delivery address at the time the correspondence was delivered, Ms. Heckman's failure to respond to the letter would constitute a constructive refusal to sign. The copy of the FedEx shipping label does not demonstrate that the letter was delivered to Ms. Heckman.

II. Renewed Petition Under 1.137(b)

As set forth in the previous decision, the "required reply" element of a grantable petition for revival requires either an acceptable declaration executed by the legal representative on behalf of the deceased inventor or a grantable petition under 37 CFR 1.47(a) for acceptance of the declaration without the legal representative's signature. The present petition, under 37 CFR 1.47(a), is not grantable on the present record, and applicants have not submitted a declaration executed by the legal representative. The "required reply" element of a grantable petition has therefore not been satisfied. Accordingly, the renewed petition for revival cannot be granted on the present record.

CONCLUSION

The petition under 37 CFR 1.47(a) seeking acceptance of the application without the signature of the legal representative of deceased inventor Markus Heckmann is **DISMISSED** without prejudice.

The renewed petition for revival under 37 CFR 1.137(b) is **DISMISSED** without prejudice.

The instant application remains **ABANDONED**.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a renewed petition under 37 CFR 1.137(b) and a renewed petition under 37 CFR 1.47(a).

Any further correspondence with respect to this matter should be addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, VA 22313-1450, with the contents of the letter marked to the attention of the PCT Legal Office.

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